

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claim 79 was amended to overcome the objection thereto.

Claims 71 and 76-79 were rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Applicants respectfully traverse.

The Examiner alleges that the specification does not support an instrument or tool "consisting of" a biocompatible inert material. Page 3, lines 1-2 of the specification, however, disclose that medical/surgical instruments are "prepared from biocompatible bioinert materials" which provides support for the rejected claims. Note that the instrument may also be coated with the materials, which is an alternative embodiment for those tools that "consist of" the biocompatible inert material.

Also, see page 6, last line to the top of page 7, wherein it is explained that "[i]n connection with the invention, when medical/surgical instruments are mentioned, this is to be understood as including instruments and tools which consist at least in part of biocompatible bioinert materials....." which, by definition, would include those tools that "consist of" the biocompatible bioinert material. In view of the foregoing, this rejection should be withdrawn.

Claims 59, 64, 66, 70, 71, 76, 77 and 83 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Tatematsu. Applicants respectfully traverse.

Tatematsu relates to a yarn cutter for a shuttleless loom. The Examiner alleges that the scissors are "perfectly capable of being used in surgery", but, referring to the drawings, there are no thumb/finger holes disclosed for a surgeon to use the scissors. Furthermore, there is no disclosure that the material is "biocompatible bioinert". Each and every limitation of the claims is not taught or suggested by Tatematsu, nor would

Tatematsu be concerned with biocompatibility or bioinertness, so the rejection must be withdrawn.

Claims 59, 63, 66, 67, 71, 76, 77, 78 and 83 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Lilley. Applicants respectfully traverse.

It is respectfully submitted that Lilley is not available as a 102(e) reference, so the rejection must be withdrawn.

Furthermore, Lilley discloses an artificial bioprosthesis with a head that may be made of YTZP. The Examiner alleges that one would "hammer" with the device, but that is not supported by any objective evidence. Even if used a "trial device" as alleged by the Examiner, it is not a "tool" to be used in surgery, it is an implant to be implanted in a subject.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

Claims 59, 63, 64, 66, 67, 70 and 83 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of Jones and Chatterjee. Applicants respectfully traverse.

At col. 3, line 11, Jones discloses that "[i]nsulating coating 16 is offset from cutting edge 14. As used herein, the term 'offset' means not completely covering. The exposed width of the cutting edge, i.e., not covered with insulating coating 16,.....". IT is taught that cutting edge 14 is made of, e.g., stainless steel, Jones does not disclose that his instrument will not form iron particles during use. Chatterjee does not overcome this deficiency, so the rejection should be withdrawn.

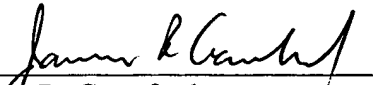
Note that Lilley, at col. 8, lines 1-3, indicates that there are medical grade zirconia ceramics, which is not believed to be taught by Chaterjee.

In view of the foregoing, allowance is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0624, under Order No. NY-CERA 233-US.

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Respectfully submitted,

By 

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